

The Examiner has proposed to modify a "scanning device" referred to in the "BACKGROUND OF THE INVENTION" section of the subject application to create an apparatus that has the capability to perform as recited in the limitations of claim 1, claim 13, and claim 18. The specific portion of this section to which the Applicant believes the Examiner is referring is "[i]n scanning devices that move an object to be scanned relative to a fixed optical sensor . . ." The Examiner has proposed to modify this "scanning device" according to teachings included in Ogura.

On page 3 of the Examiner's office action, in the first paragraph, the Examiner has indicated that the teachings of Ogura relied upon in making the rejections of claims 1-22 under 35 U.S.C. § 103(a) are included from column 7, line 50 through column 8, line 20. Ogura states, at column 7, lines 57-59, "[n]ext, 1<sup>st</sup> optical unit 53 is moved from position C to a position D, that is, a distance 12 + 11 + 13, so as to optically scan the 1<sup>st</sup> original document 01.(MV2)." Furthermore, Ogura states, at column 7, lines 63-67, "[s]imilarly, distance 13 is provided for deceleration of 1<sup>st</sup> optical unit 53, thereby causing 1<sup>st</sup> optical unit 53 to be stopped after 1<sup>st</sup> optical unit 53 is moved from position B to position A, which is distance 11."

The Examiner's proposed modification to the "scanning device" would create an apparatus that makes use of a capability to "move an object to be scanned" and makes use of a capability to move an "optical unit" to perform scanning. The Examiner proposes to make these modifications to create an apparatus that operates in a way so that claim 1, claim 13, and claim 18 read upon this apparatus. However, the principle of operation of the prior art "scanning device" that the Examiner proposes to modify by teachings included in Ogura is that it moves "an object to be scanned relative to a fixed optical sensor . . ." Therefore, the Examiner's proposed modification changes the principle of operation of the prior art "scanning device" that is to be modified.

According to MPEP section 2143.01, last paragraph, "[i]f the proposed **modification** or combination of the prior art **would change the principle of operation** of the prior art invention being modified, then **the teachings** of the references **are not sufficient** to render the claims *prima facie* obvious" (emphasis added). Therefore, because modification of the prior art "scanning device" would change its principle of operation, a valid *prima facie* obviousness rejection of claim 1 has not been established.

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According, the Applicant respectfully requests withdrawal of the rejection of claim 1, claim 13, and claim 18 under 35 U.S.C. § 103(a).

Furthermore, according to section 2143.03 of the MPEP "[i]f an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious." Therefore, because claim 1, claim 13, and claim 18 are nonobvious, claims 2-12, claims 14-17, and claims 19-22 which are dependent either directly or indirectly on, respectively, claim 1, claim 13, and claim 18, must be nonobvious. Accordingly, the Applicant respectfully requests withdrawal of the rejections of claims 2-12, claims 14-17, 19-22 under 35 U.S.C. § 103(a).

In addition to the arguments presented in the previous paragraphs, the Applicant contends that there is another basis for showing that the Examiner has not made a valid prima facie obviousness rejection under 35 U.S.C. § 103(a) of claim 1, claim 13, and claim 18. According to MPEP 2143.01, "[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention **where there is some teaching, suggestion, or motivation** to do so found either in the references themselves **or in the knowledge generally available** to one of ordinary skill in the art." In addition, MPEP 2143.01 states that "[t]he level of skill in the art **cannot be relied upon** to provide the suggestion to combine references." (emphasis added) The Applicant respectfully contends that the Examiner has not shown where there is a "teaching, suggestion, or motivation" to modify the teachings of the prior art to produce the invention recited in claim 1, claim 13, and claim 18.

The Applicant respectfully contends that no such teaching, suggestion, or motivation can be found in the disclosure of Ogura. As stated in column 1, lines 31-35 of Ogura, "[i]t is an object of the present invention to provide an improved image forming apparatus **in which the location of the boundary between original documents is clearly known** and in which two original documents may be properly set in place." (emphasis added) From the section of Ogura relied upon by the Examiner in making the rejection of claim 1, claim 13, and claim 18, and from Figure 4 of Ogura, it can be seen that "distance 13", which is "provided for **deceleration** of 1<sup>st</sup> optical unit 53" is over the "2<sup>nd</sup> original document 02" not the document actually scanned "1<sup>st</sup> original document 01" in the move "from position C to a position D." Furthermore, there is no disclosure in the section of Ogura cited by the Examiner that could serve as the teaching, suggestion, or motivation

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to modify the "scanning device" to create an apparatus that could solve the problem discussed in the subject application. Therefore, it appears that the section of Ogura relied upon by the Examiner in making the rejection of claim 1, claim 13, and claim 18 does not provided the teaching, suggestion, or motivation required by MPEP 2143.01. If the Applicant has failed to recognize this teaching, suggestion, or motivation, the Applicant respectfully requests the Examiner to specifically show the Applicant where it exists.

#### Conclusions

The Applicant respectfully contends that the Examiner's rejections of claims 1-22 have been successfully traversed. Accordingly, the Applicant believes the subject application is in a condition for allowance. Such action is respectfully requested.

Respectfully submitted,  
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January 6, 2003  
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